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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/687,212

10/16/2003

John T. Mariner

131966-2

7158

36580

7590

10/13/2004

GE SPECIALITY MATER
ONE PLASTICS AVENUE
PITTSFIELD, MA 01201

EXAMINER

PAIK, SANG YEOP

ART UNIT PAPER NUMBER

3742

DATE MAILED: 10/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/687,212	Applicant(s) MARINER ET AL.	
	Examiner Sang Y Paik	Art Unit 3742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---------------------------------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/23/04, 3/15/04, 10/16/03</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/277,786. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application '786 recites the all the elements of the pending application '212 including a graphite body forming a electrical flow path pattern with an encapsulating coating layer such as boron nitride applied before or prior to forming such electrical flow pattern, the terminals formed by the opposed ends of the electrical heating circuit, a continuous second surface of nitride layer such as a boron nitride over the coated graphite body, the coating of the boron nitride formed by the chemical vapor deposition, and the electrical flow path in the form of a spiral or serpentine shape by a machine operation

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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With respect to claim 13 and 21, it would have been obvious to one of ordinary skill in the art to provide the graphite body in a disk, platen or cylinder since the shape of the heater would have been dependent upon the desired use of such heater in various applications.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert Sr (US 6,140,624) in view of Miram (US 4,263,528).

Gilbert Sr shows a heater including a graphite body (14) formed in an electrical pattern with terminal ends, a first coating layer (16) made of boron nitride encapsulating the graphite body, and a second continuous surface coating layer made of carbide formed over the heating surface formed by the coated graphite body. The first and second coating layers are formed by the chemical deposition process, and the electrical pattern of the graphite body forming the spiral and serpentine shape has been configured by the machining process. However, Gilbert Sr does not show that the first coating layer has been applied prior to forming the electrical pattern in the graphite body.

Miram shows a graphite body that is coated with a boron nitride layer (24) prior to forming an electrical pattern thereon by the chemical etching process. Miram further shows that other similar layer of boron nitride such as tungsten or molybdenum can be alternatively used. In view of Miram, it would have been obvious to one of ordinary skill in the art to apply the first

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boron nitride prior to forming the electrical pattern in the graphite body as an alternative process to effectively form such electrical pattern on the graphite body along with the coated boron nitride layer.

With respect to claim 8, it would have been obvious to one of ordinary skill in the art to use boron nitride or aluminum nitride in place of the carbide material of the second coating layer since the boron nitride and aluminum nitride are known to provide an good insulating properties as well as suitable radiation emissivity.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kano et al (US 6,242,719) and Kimura et al (US 5,882,730).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sang Y Paik whose telephone number is 703-308-1147. The examiner can normally be reached on M-F (9:00-4:00) First Friday Off.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sang Y Paik
Primary Examiner
Art Unit 3742

S. R.

syp